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09/698,255	10/30/00	SEKIGUCHI	K 35.62225 DIV

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EXAMINER

DINH, K

ART UNIT

PAPER NUMBER

2155

DATE MAILED:

04/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/698,255

Applicant(s)

Sekiguchi

Examiner

Dinh Khanh

Group Art Unit

2155



☒ Responsive to communication(s) filed on Oct 30, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 29-43 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 29-43 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This is in response to the preliminary amendment filed on 10/30/2000. Claims 1-28 are canceled. Claims 29-43 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 29-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa US pat. No.5,765,170 in view of Cannale et al US pat. No.5,619,648.

As to claim 29, Morikawa discloses a communication device comprising:

an acquisition means for acquiring the size information of an e-mail, stored in an e-mail server (6 fig.1), from said e-mail server;

a reception means (F0 fig.1) for receiving an e-mail at said communication device from said e-mail server (see fig.1, abstract, col.5 line 57 to col.6 line 49);

memory for storing e-mails received by said reception means (see fig.1, dedicate folders);

a judgment means for judging (controlling information) whether it is possible or not to receive at said communication device an e mail stored in said e-mail server, according to said

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size information and empty capacity of said memory (see fig.1 and 2, col.6 line 2 to col.7 line 37 and col.8 lines 15-67);

Morikawa does not specifically disclose an output means for visually outputting warning information. However, Cannale discloses an output means for visually outputting warning information (using mail filter 119 fig.1) indicating that an e-mail to said communication device, stored in said e-mail server, cannot be received, as a result of said judgment, when said judgment means makes such judgment (see figs.1 and 3, abstract, col.3 line 12 to col.4 line 34 and col.7 line 28 to col.8 line 56). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to utilize Cannale's filter into the system of Morikawa to prevent unwanted data because it would have reduced the amount of unwanted data received by a user of the email system.

As to claim 30, Morikawa discloses size information contains the size of data when an e-mail received from said e-mail server contains various kinds of data (see col.1 line 46 to col.2 line 26 and col.8 lines 15-67). Morikawa does not specifically disclose data is an image data. However, image data is well known in the art. It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement such data into the system of Morikawa because it would have provided more utilizations of data in the communication network.

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As to claim 31, Cannale further discloses a recording means, wherein said output means generates a report indicating said warning information and records it using said recording means (see col.3 line 13 to col.4 line 33 and col.7 line 7 to col.8 line 56). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to utilize Cannale's teachings into the system of Morikawa to prevent unwanted data because it would have reduced the amount of unwanted data received by a user of the email system.

As to claim 32, Morikawa discloses converting a received e-mail into image data and records that e-mail using said recording means (see col.8 line 15 to col.9 line 9).

As to claim 33, Morikawa discloses when a plurality of e-mails are stored in an e-mail server, a communication device executes reception of emails from said e-mail server in a predetermined order, until said judgment means judges that it is impossible to receive an e-mail (see col.2 line 29 to col.3 line 14, col.6 line 33 to col.7 line 58).

Claims 34-38 are rejected for the same reasons set forth in claims 29-33 respectively.

Claims 39-43 are rejected for the same reasons set forth in claims 29-33 respectively.

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Other prior art cited

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Holt et al. US patent no.5,557,723: Method and system for customizing forms in an electronic mail system.

Conclusion

5. Claims 29-43 are rejected.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (703) 308-8528. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh, can be reached on (703) 305-9648. The fax phone number for this group is (703) 305-7201.

A shortened statutory period for reply is set to expire THREE months from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned (35 U.S.C. Sect.133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(A).


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 -9600.

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Khanh Dinh
Patent Examiner
Art Unit 2155
4/18/2001


AYAZ SHEIKH
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